

REMARKS

Reconsideration of this application, in view of the foregoing amendment and the following remarks, is respectfully requested.

Claims 1-5 were originally presented for consideration in this application. Claims 6-14 were added by previous amendments. Claims 5 and 9 have previously been canceled without prejudice or disclaimer. Accordingly, claims 1-4, 6-8 and 10-14 are currently pending in this application.

The following rejections were set forth in the Office Action:

1. Claims 6-8 stand rejected under 35 USC §102(b) as being unpatentable over U.S. Patent No. 6,173,788 (Lembcke).
2. Claims 1-4, 10-12 and 14 stand rejected under 35 USC §103(a) as being unpatentable over U.S. Patent No. 6,173,788 (Lembcke) in view of U.S. Patent No. 4,137,970 (Laflin).

Regarding the anticipation rejections based on the Lembcke reference, the Office Action states that the through-going opening recited in the claim is disclosed at col. 2, lines 48-57 of Lembcke. Independent claim 6 has been amended above to make it clear that the through-going opening is positioned between an inner surface and an outer surface of the packer.

Lembcke does not describe such a through-going opening in combination with a slit extending between the through-going opening and the outer surface of the packer prior to actuation of the packer. Therefore, Lembcke does not anticipate claim 6, and withdrawal of the rejections of this claim and its dependents is respectfully requested.

Regarding the obviousness rejections based on the Lembcke and Laflin references, please note that independent claims 1 and 11 have also been amended above in a manner similar to that discussed above for claim 6. Since neither of the Lembcke and Laflin references teach or suggest these features of the invention as now recited in claims 1 and 11, a *prima facie* case of obviousness does not exist for these claims. Accordingly, withdrawal of the rejections of these claims and their dependents is respectfully requested.

In view of the foregoing amendment and remarks, all of the claims pending in this application are now seen to be in a condition for allowance. A Notice of Allowance of claims 1-4, 6-8 and 10-14 is therefore earnestly solicited.

The examiner is hereby requested to telephone the undersigned attorney of record at (972) 516-0030 if such would expedite the prosecution of the application.

Respectfully submitted,

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I hereby certify that this correspondence is being
filed in the U.S. Patent and Trademark Office
electronically via EFS-Web, on April 22, 2009.

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